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EXXONMOBILE CHEMICAL COMPANY
PO BOX 21495200 BAYWAY DRIVE
BAYTOWN, TX 77522-2149

In re Application of:	:	OFFICE OF PETITIONS
Jean-Marc Francois	:	
Application No. 10/822,188	:	DECISION DISMISSING
Filed: April 6, 2004	:	PETITION UNDER
Attorney Docket No.: 2002B098/2	:	37 CFR 1.47(b)

This is in response to the Declaration and Petition of Facts in Support of Filing on Behalf of Inventor who Refuses to Sign or Cannot be Reached (37 CFR 1.47(b)), to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors.

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor, and be addressed to Petitions Attorney Derek L. Woods. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on April 6, 2004, without an oath or declaration. Applicant files the instant petition and declaration to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors. In support of the petition, Applicant declares, in relevant part, that the invention was invented and made under the direction of ExxonMobile within the conduct of his employment, and that the inventor was under an obligation to assign the invention to ExxonMobile. This Applicant avers, demonstrates ExxonMobile's vested proprietary

interest in the invention. *Petition* at p.1. Applicant further declares that the application was sent to the inventor at his last known address and that the result was that either the inventor refused delivery, or the inventor has moved. Applicant declares that efforts to locate the inventor are continuing. Applicant files an unexecuted Declaration of the Invention and an unexecuted Assignment of the invention.

Applicable Law

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor(s); (5) proof of proprietary interest; and (6) proof of irreparable harm. Applicant lacks items (1), (2), and (5) as set forth above.

Decision

As to item (1), 37 CFR 1.47(b) provides for two separate and distinct circumstances to allow an application to proceed without the signature of the inventor(s). The first is where an inventor refuses to sign an application after having been presented with the application for signature, and the second is where an inventor cannot be found or reached after diligent effort. The situations are separate and distinct and require separate and distinct steps in order to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors.

In this instance, Applicant avers that either the inventor refuses to join in the application after having been presented with the application, or the whereabouts of the inventor are unknown. Where the whereabouts of the nonsigning inventor are known, what is required is that the application (specification, claims and drawings, along with the oath or declaration for signature) be presented (mailed) to the nonsigning inventor at his or her last known address, before a refusal to join the application can be alleged.

Conversely, where the nonsigning inventor cannot be found or reached after diligent effort, a diligent effort to find or reach the nonsigning inventor is required before an applicant is allowed to proceed with the application. A statement of facts should be submitted that fully describes the exact facts which are relied upon to establish that a diligent effort was made. The statement of facts must be signed by a person with firsthand knowledge of the facts recited therein. Copies of documentary evidence that support a finding that the nonsigning inventor cannot be found or reached should be made part of the statement. At the very least a search of the internet and local telephone directories should be undertaken in an effort to locate the nonsigning inventor. The results of said searches should be included in the petition. See MPEP 409.03(d)

As to item (2), the Office notes that pursuant to Section 409.03(b) (A) of the Manual for Patent Examining Procedure:

Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or *the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation.* Where the oath or declaration is being signed on behalf of an assignee, see MPEP Section 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). (Emphasis supplied). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be

stated if signing on behalf of a corporation under 37 CFR 1.47(b).

Applicant has not presented an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 37 CFR 1.64. A properly executed oath or declaration is required.

As to item (5), applicant failed to show or provide proof that ExxonMobile has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and the Rule 47(b) applicant (company), a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: 2201 South Clark Place
 Customer Window
 Crystal Plaza Two, Lobby Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.


Derek L. Woods
Petitions Attorney
Office of Petitions